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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,918	09/16/2003	Richard A. Wilsak	37,512	2288

7590 06/15/2006

BP America Inc.
Docket Clerk, BP Legal, M.C. 5East
4101 Winfield Road
Warrenville, IL 60555

EXAMINER

POPOVICS, ROBERT J

ART UNIT	PAPER NUMBER
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1724

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/663,918

Applicant(s)

WILSAK ET AL.

Examiner

Robert J. Popovics

Art Unit

1724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 17-39 and 50-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 40-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/9/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Election/Restrictions***

Applicant's election with traverse of **OF-2**, **DF-2** and **FZ-1** in the reply filed on **May 9, 2006** is acknowledged. The traversal is on the ground(s) that ***“the Examiner’s restriction requirement the defined groups in the Office Action would improperly require Applicants to divide individual claims on an element-by-element basis and/or eliminate dependent claims in which Applicants are entitled too.”*** This is not found persuasive because all election/restriction requirements divide claims into groups. Applicants have not made clear what they believe is ***“improper.”*** The argued dividing of ***“individual claims on an element by element basis”*** is believed to stem from a misunderstanding of the election of species requirement. Moreover, non-elected dependent claims that depend from an allowable independent claim are subject to rejoinder. The requirement is still deemed proper and is therefore made FINAL.

Elections	
OF-2	Pneumatic
DF-2	Gas
FZ-1	Concentration

Legend: E = Elected; G = Generic; N = Non-Elected

Claim	OF Species	DF Species	FZ Species	Examined?
1	G	G	E	Yes
2	G	E	G	Yes
3	G	G	G	Yes
4	G	G	G	Yes
5	G	G	G	Yes
6	G	G	G	Yes
7	G	G	G	Yes
8	G	G	G	Yes
9	G	G	G	Yes
10	G	G	G	Yes
11	G	G	G	Yes
12	G	G	G	Yes

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13	G	G	G	Yes
14	G	G	G	Yes
15	G	G	G	Yes
16	G	G	G	Yes
17			N	No
18			N	No
19			N	No
20			N	No
21			N	No
22			N	No
23			N	No
24			N	No
25			N	No
26			N	No
27			N	No
28			N	No
29			N	No
30			N	No
31			N	No
32			N	No
33			N	No
34			N	No
35			N	No
36			N	No
37			N	No
38			N	No
39			N	No
40	G	G	G	Yes
41	G	E	G	Yes
42	G	G	G	Yes
43	G	G	G	Yes
44	G	G	G	Yes
45	G	G	G	Yes
46	G	G	G	Yes
47	G	G	G	Yes
48	G	G	G	Yes
49	G	G	G	Yes
50			N	No
51			N	No
52			N	No

Since claims 1-16 and 40-49 are all either generic, or read on all of the elected species, this group of claims shall be examined.

Claim Rejections - 35 USC § 102

Claims 1-6 and 13-16 are rejected under 35 U.S.C. 102(a) as being anticipated by Benesi (either of US 6,491,817 or 6,521,135). See the Figures.

Claims 40-49 are rejected under 35 U.S.C. 102(b) as being anticipated by Hansen (US 5,004,860). See the disclosed "*slurry filter units.*"

Claim Rejections - 35 USC § 103

Claims 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benesi (either of US 6,491,817 or 6,521,135).

These claims specify details of the slurry. Given the broad disclosure of Benesi, it is submitted that use of the system disclosed by Benesi to process the slurry now being claimed, would have been readily apparent to those skilled in the art.

Any inquiry concerning this communication should be directed to Robert J. Popovics at telephone number (571) 272-1164.

A large, stylized handwritten signature in black ink, likely belonging to Robert James Popovics, positioned above his printed name.

Robert James Popovics
Primary Examiner
Art Unit 1724

A smaller, stylized handwritten mark or signature in black ink, located below the printed name of the examiner.

June 12, 2006